

12 and 15-16 stand rejected under 35 U.S.C. § 103(a) as being obvious and unpatentable over Levey in view of Lasher et al., U.S. Patent 5,771,657. The Examiner has also rejected pending claims 17, 18, 21-25 and 28-31 as obvious over Lasher in view of Levey. For the reasons presented below, reconsideration and withdrawal of the rejections respectfully are solicited.

Claims 1, 2, 4, 7, 11, 13 and 14

Initially, it respectfully is submitted that the Examiner has misinterpreted the disclosure of Levey. Levey can not anticipate these claims, as Levey does not disclose all the elements of claim 1 or the other rejected claims, all of which depend from claim 1. Specifically, Levey does not disclose individually reconfigurable compartments for receiving different container sizes.

Claim 1 requires, among other things:

- a. a pallet comprising a structure defining a plurality of compartments for holding containers, each compartment of a size adapted to hold a first container size; and
- b. a plurality of pucks, each puck structured to be removeably loaded onto the pallet to adapt a compartment to hold a second container size.

By contrast, Levey teaches only a structure configured to receive a plurality of identically-sized containers: “It is contemplated that sets of *containers of a given size* will be loaded onto container support trays which will be carried from one cascaded bay to the next on support rails. . . . In this manner, support trays of *containers of a particular size and shape* can be processed by operatively selecting the nozzle bank within the cleaning bay suitable to that particular size.” (See Levey, Column 3, lines 11-23). As confirmed in FIGS. 1, 2, 4, and 5, Levey merely concerns the use of fixed-spacing tray inserts 29, which may be installed on the

support tray 17 to accommodate groups of containers, *all of one size*.

Levey has a single container support tray 17, which is received in a cleaning bay. By itself, the support tray is not configured to receive containers. Without the tray insert 29, the support tray 17 of Levey has no provision for receiving or supporting containers. In order to accommodate containers to be processed in the cleaning bay, a fixed-spacing tray insert 29 (see FIG. 2) must be installed upon the support tray 17. Accordingly, the support tray 17 of Levey alone does not disclose or suggest “a structure defining a plurality of compartments for holding containers, each compartment of a size adapted to hold a first container size.” Consequently, since the support tray 17 cannot “hold a first container size,” neither can Levey’s tray insert 29 serve as a “puck” to adapt the support tray “to hold a second container size.”

Even if Levey’s support tray 17 and tray insert 29 together satisfied the limitation of “a structure defining a plurality of compartments for holding containers, each compartment of a size adapted to hold a first container size” (which they do not), Levey does not disclose anything in the nature of “a plurality of pucks, each puck structured to be removeably loaded onto the pallet to adapt a compartment to hold a second container size.” Nor does Levey disclose any other means for repeatedly reconfiguring individual compartments to hold different container sizes, as accomplished by applicant’s invention.

The tray insert of Levey does not adapt an individual compartment of a preexisting plurality of compartments to hold a different container size. At best, each Levey tray insert, when combined with the Levey support tray, is the same as a preexisting fixed plurality of compartments having a predetermined fixed configuration. Therefore, under the teachings of Levey, a second container size can be accommodated only by switching between separate preconfigured tray inserts, which necessarily changes the configuration of *all* of the plurality of

compartments. In sum, Levey does not teach any structure to selectively reconfigure *an individual compartment* to hold a second container size, as in the present invention.

In fact, Levey teaches *against* the use of individually configured compartments, because assorted container sizes within a cleaning bay would run counter to Levey's objective of operating a selected set of nozzle elements specifically tailored to clean a set of containers of a particular size. To this end, Levey discloses "two independently operable sets of nozzle elements . . . adapted to clean different sized containers" and "in each cleaning bay, operatively selecting a set of nozzle elements depending on the size of the set of containers being processed." (See Levey, Column 14, lines 44-55). Clearly, Levey contemplates having only a single-size set of containers in a cleaning bay at a time, so that a selected set of nozzle elements, specifically tailored to clean containers of a particular size, can be used.

Consequently, Levey's structure does not and do what is specified in the claim, namely, that "the pallet can be repetitively configured to hold various desired *combinations of containers of the first size and the second size* by loading and unloading pucks from the pallet." Levey does not disclose any modification of individual compartments to hold combinations of different container sizes – there is no disclosure of reconfigurable individual compartments. Accordingly, because this essential element is lacking in Levey, Levey cannot anticipate claim 1, 2, 4, 7, 11, 13 or 14 of the present invention.

It is well settled that anticipation requires "identity of invention." *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 U.S.P.Q.2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim. *In re Marshall*, 198 U.S.P.Q. 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 221 U.S.P.Q. 481, 485. There must

be no differences between what is claimed and what is disclosed in the prior art reference. *In re Kalm*, 154 U.S.P.Q. 10, 12 (C.C.P.A. 1967).

As discussed, above, Levey does not disclose a puck structure to selectively reconfigure *an individual compartment* to hold a second container size, as in the rejected claims. Thus, since Levey does not disclose each and every element cited in the pending claims, there is no identity of invention between the pending application and the Levey reference. Accordingly, and inasmuch as the sole consideration under § 102 is whether the claims of an application are anticipated by a single reference, the § 102 rejection is insufficient as a matter of law, and must be withdrawn. *Marshall*, 198 U.S.P.Q. at 346; *Lindermann*, 221 U.S.P.Q. at 485.

Furthermore, the Examiner fails to cite any other reference disclosing a structure to adapt an individual compartment of a multiple compartment pallet to hold a second container size. There is no basis for a rejection under 35 U.S.C. § 103(a).

Claims 3, 5, 8, 9, 10, 12 and 15-16

Claims 3, 5, 8, 9, 10, 12 and 15-16, all of which depend from claim 1, stand rejected under 35 U.S.C. § 103(a) as being obvious and unpatentable over Levey et al. in view of Lasher et al., U.S. Patent 5,771,657. The Examiner contends that “Levey substantially shows the claimed subject,” but does not show a conveyor with multiple pallets or prescription filling components. The Examiner further asserts that Lasher discloses a conveyor with multiple pallets or prescription filling components and that it would have been obvious to use the carrier of Levey to fill prescription bottles with the components of Lasher.

However, as in the previous rejection above, because the Examiner’s foundational assertion, that Levey discloses a removable puck for selectively and repetitively configuring

individual compartments of a pallet, is incorrect, this rejection cannot stand. Accordingly, the Examiner has failed to establish a prima facie case of obviousness because the combination of the cited references does not teach or suggest all of the limitations of the independent claim 1. *See In re Royka*, 490 F.2d 981, 985 (CCPA 1974); MPEP § 2143.03. For these reasons, applicants respectfully submit that the independent claim is nonobvious and allowable. Hence, the rejected dependent claims must also be nonobvious because they depend from a nonobvious base claim. *See In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicants respectfully assert that the rejection under Section 103 should be withdrawn.

Furthermore, the additional limitations contained in dependent claims 3, 5, 8, 9, 10, 12 and 15-16 are not found in Lasher. For example, contrary to Examiner's assertion, Lasher does not show the use of tags to store information relating to the carrier configuration (as found in claims 9 and 15 of this application). Lasher concerns only a fixed pallet ("carrier") configuration having four large compartments ("wells") and twenty small compartments: "The leading row which consists of four wells are sized to accommodate the large sized bottles and the remaining five rows are sized to receive the small bottles." (Lasher, Column 5, lines 1-5). Hence, there is no variation in the configuration of the compartments from pallet to pallet, and consequently, there is no means disclosed for tracking such nonexistent configuration variation.

Similarly, Lasher does not show the use of tag readers to read information stored on tags indicative of the carrier configuration as found in claims 10 and 16 of this application. Lasher has only "an RFID tag which uniquely identifies the carrier." (Lasher, Column 5, lines 13-14). For the further reason that these additional limitations in the dependent claims are lacking in the cited art, the Examiner's rejection under Section 103 should be withdrawn.

Claims 17, 18, 21-25 and 28-31

The Examiner has also rejected all of the pending claims 17, 18, 21-25 and 28-31 as obvious over Lasher in view of Levey. Of these claims, claims 17, 28 and 29 are independent claims. The remaining claims 18, 21-25 all depend from independent claim 17, and claims 30 and 31 depend from independent claim 29.

Independent claims 17, and 29 require, among other things:

A plurality of pallets having a plurality of compartments for holding containers, each compartment of a size adapted to hold a first container size; and
a plurality of pucks, each puck configured to be temporarily inserted into a compartment to adapt the compartment to hold a second container size.

Independent claim 28 requires, among other things:

A plurality of pallets, each having a plurality of compartments for holding pucks; and
a plurality of pucks of at least two configurations, for temporary insertion into a compartment to adapt the compartment to hold one of at least two respective container sizes.

As in the previous rejections above, the Examiner's foundational assertion – that Levey discloses a removable puck for selectively and repetitively configuring individual compartments of a pallet, as required by independent claims 17, 28, and 29 – is incorrect. Therefore, this rejection cannot stand. As detailed above, Levey does not disclose any means for selectively reconfiguring individual compartments of a pallet.

The Examiner's Rejections Are Deficient as a Matter of Law

Because the Examiner has misinterpreted the primary piece of art, Levey, and because the rejections are based on a misinterpretation of fact, as a matter of fact and law, the rejections should be withdrawn. *See Ex parte Porter*, 25 USPQ2d 1144, 1147 (BPAI 1992)(reversing a rejection based on a misinterpretation of the disclosure of a reference); *Ex parte Levy*, 17 USPQ2d 1461, 1465 (BPAI 1990)(same). Moreover, even if the Examiner were correct in his analysis of Levey, the rejection would still fall short, because it lacks the requisite suggestion and motivation as to *why* one skilled in the art would have selected the art the Examiner selected and *why* one would have been led to combine Levey and Lasher as the Examiner did.

As noted above, in making the rejection, the Examiner merely asserted that all of the elements of prescription filling apparatus are "known in the art," and that "it would have been obvious to provide the carrier means of Levey et al. with the various components in prescription filling of Lasher et al. to fill prescriptions in bottles as is known in the art." (Office Action, p. 3, lines 12 - 15). Thus, the Examiner asserted that one could make a modification to Levey merely because the element exists in the art. The Examiner's assertion is even more tenuous because Levey relates to apparatus for cleaning sample containers for environmental testing, an area of art far removed from the automated prescription dispensing systems of the present invention.

Whether or not all of the elements recited in the rejected claims were "known" or can be found in the art is absolutely insufficient to support a rejection under 103. As Judge Rader explained in *In re Rouffet*:

"virtually all [inventions] are combinations of old elements." . . . Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of

each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability."

In re Rouffet 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1993).

Thus, because the Examiner relied on an "Is-it-known" standard, and because that standard has been expressly rejected, the rejection should be reversed.

Moreover, the Examiner never attempted to explain *why* one would have been *led* to deviate from Levey's teachings and modify Levey precisely at that point, and *why* one would have looked to Lasher, rather than any other document, to modify Levey precisely at that point.

But such explanations are what a conclusion of obviousness requires:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, ***the examiner must show reasons that the skilled artisan***, confronted with the same problems as the inventor and with no knowledge of the claimed invention, ***would select the elements from the cited prior art references*** for combination in the manner claimed.

* * * *

In other words, the [Examiner] must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

In re Rouffet 149 F.3d 1350, 1357, 1359, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1993)(emphasis added).

Thus, because the Examiner failed to identify any suggestion or motivation for *why* one would have been *led* to select and modify the cited art as the Examiner did, the rejection should be withdrawn.


An Examiner "must indicate where a teaching or suggestion appears in the reference." *In re Rinehart*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Here, the Examiner did not

meet that initial burden. *See also In re Lee*, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (emphasizing the importance of providing objective evidence and making specific factual findings with respect to the motivation to combine references). As is apparent from a review of the Office Action, nowhere is there any evidence or even an allegation that one would have been motivated to deviate at that precise point from the system of Levey and make the combination the Examiner made.

Beyond all of the foregoing, the Examiner's argument that it would have been obvious to modify Levey is not only not the standard under 103, to undersigned's knowledge, no case has affirmed a rejection based on an "obvious to modify" rationale. And the Examiner cites none. So that the record is clear, should the Examiner maintain the rejection in view of all of the foregoing, it respectfully is requested that the Examiner provide authority to support his rationales.

In view of all of the foregoing, reconsideration and withdrawal of the rejections, and allowance of all claims, respectfully are solicited.

Respectfully submitted,

By: 
Robert G. Lancaster
Registration No. 43,736
BRYAN CAVE LLP
One Metropolitan Square
211 North Broadway, Suite 3600
St. Louis, Missouri 63102-2750
(314) 259-2000 (Telephone)
(314) 259-2020 (Facsimile)